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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|--|-------------|----------------------|-----------------------------|------------------|
| 09/771,146 | 01/26/2001 | George Coleman | 06620/026001 | 6198 |
| 20985 | 7590 | 09/16/2002 | | |
| FISH & RICHARDSON, PC 4350 LA JOLLA VILLAGE DRIVE SUITE 500 SAN DIEGO, CA 92122 | | | EXAMINER MULCAHY, JOHN M | |
| | | | ART UNIT 3739 | PAPER NUMBER |
| | | | DATE MAILED: 09/16/2002 | |

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|-----------------|----------------|-----------|
| Office Action Summary | Application No. | Applicant(s) | <i>CR</i> |
| | 09/771,146 | COLEMAN ET AL. | |
| Examiner | Art Unit | | |
| John M. Mulcahy | 3739 | | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) Responsive to communication(s) filed on 03 June 2002.

2a) This action is FINAL. 2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) Claim(s) 1-137 is/are pending in the application.

4a) Of the above claim(s) See Continuation Sheet is/are withdrawn from consideration.

5) Claim(s) _____ is/are allowed.

6) Claim(s) See Continuation Sheet is/are rejected.

7) Claim(s) _____ is/are objected to.

8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) The proposed drawing correction filed on _____ is: a) approved b) disapproved by the Examiner.
 If approved, corrected drawings are required in reply to this Office action.

12) The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
 a) The translation of the foreign language provisional application has been received.

15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) Notice of References Cited (PTO-892) 4) Interview Summary (PTO-413) Paper No(s). _____.
 2) Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) Notice of Informal Patent Application (PTO-152)
 3) Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____. 6) Other:

Continuation of Disposition of Claims: Claims withdrawn from consideration are 3-6,25,31,40-48,51-53,58-60,68,69,71,73-75,77,82-84,91-96,98,99,101,102,104,108-114,120-129,136 and 137.

Continuation of Disposition of Claims: Claims rejected are 1,2,7-24,26-30,32-39,49,50,54-57,61-67,70,72,76,78-81,85-90,97,100,103,105-107,115-119 and 130-135.

Election/Restrictions

1. Applicant's election without traverse of Species A (Fig. 1A) in Paper No. 3 is acknowledged. Claims 3-6, 25, 31, 40-48, 51-53, 58-60, 68, 69, 71, 73-75, 77, 82-84, 91-96, 98, 99, 101, 102, 104, 108-114, 120-129, 136 and 137¹ are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected species, there being no allowable generic or linking claim.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 38, 54, 56, 61, 70, 130 and 135 (and their depending claims) are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

a. In claim 38, line 2, "said window" lacks antecedent. In action on the merits, this claim was interpreted as depending from claim 37, which provides antecedent.

b. In claim 54, the repeated recitation of "an optical element" is indefinite since it is unclear whether it is intended to refer to the previously recited optical element (claim 1).

¹ Although Applicant lists claims 25, 31, 40-48, 51-53, 68, 69, 71, 75, 77, 82-84, 92, 94, 95, 98, 101, 108-114, 121-124, 127-129, 136 and 137 as reading on the elected species, these are clearly drawn to the non-elected embodiments.

- c. Further in claim 54, line 2, "said electrical element" lacks antecedent in the previous recitation of an "electrical cable" (claim 28).
- d. In claims 56 and 61, "said optical element" lacks antecedent in the previous recitation of an "optical portion" (claim 55).
- e. In claim 70, the recitation, "illuminating an area of viewing" is functional absent recitation of a means or structure for illuminating.
- f. Claim 130 sets forth "A method," but recites apparatus limitations.
- g. Claim 135 depends from itself. In action on the merits, this claim was interpreted as depending from claim 134.

Claims depending from these claims are likewise indefinite.

Claim Rejections - 35 USC § 102

- 3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

- a. Claims 1, 9, 10, 18, 21, 27-29, 37, 38, 49, 50, 54, 55, 63-66, 70, 87-89, 97, 100 and 105-107 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Mersch (JP 7-163518). See the entire document. See especially Figures 1, 3 and 4; English abstract; and computer translation, paragraphs 3, 7-9, 13-16.
 - b. Claims 1, 2, 7-10, 18, 21, 27-29, 37-39, 49, 50, 54-57, 61-66, 70, 72, 76, 78-81, 85-88, 90, 97, 100, 103, 105-107, 115-119 and 134 are rejected under 35

U.S.C. 102(b) as being clearly anticipated by Sauer et al. (5,700,236). See the entire document. Note mirror 25. See especially Figures 4, 17 and 22; col. 5, last line; and the last full paragraphs in columns 8, 11 and 12.

c. Claims 1, 2, 18-21, 27-29, 32-34, 37-39, 49, 50, 54-56, 63-67, 70, 72, 76, 78-81, 85, 86, 90, 97, 100, 105-107, 115-119, 130, 132 and 133 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Eino et al. (4,869,237). See the entire document. Note sheath 7 and mirror 8. See especially Figures 3, 8 and 11 and their descriptions; col. 17, lines 26-30.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

a. Claims 11-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sauer et al. (5,700,236) as applied to claims 1 and 9 above, further in view of Karasawa et al. (5,575,756).

Sauer et al. fails to teach an O-ring or a cavity between the sleeve and endoscope. However, Karasawa et al shows such an arrangement. See Figs. 11-12 and their description. As to claim 13, see the projections 497 in the modification of Fig. 63. Inasmuch as Sauer et al. discloses a fluid conduit 78, it would have been obvious to the artisan to modify Sauer et al. by using a cavity between the sheath and endoscope

as the conduit as taught by Karasawa since Karasawa teaches that such would simplify assembly and cleaning. See col. 1, line 50 *et seq.*

b. Claims 22, 23, 26 and 131 are rejected under 35 U.S.C. 103(a) as being unpatentable over Eino et al. as applied to claims 18 and 130 above, further in view of Olympus Optical Co. (JP 10-262921) (Olympus).

Eino et al. fails to teach an image processor which rotates the image. However, Olympus teaches such a processor 34. As to claim 26, note text in Fig. 11. It would have been obvious to the artisan to modify Eino et al. by providing such an image processor and text generator since Olympus suggests that such would reduce inspection time. See English language abstract. Note that the corrected and uncorrected images are displayed simultaneously (claim 23). See Fig. 8.

c. Claim 24 is rejected under 35 U.S.C. 103(a) as being unpatentable over Eino et al. (4,869,237) in view of Olympus (JP 10-262921) as applied to claim 23 above, further in view of Matsunaka et al. (5,305,098).

Eino et al. in view of Olympus fails to teach simultaneous display of images obtained at different times. However, Matsunaka et al. shows such an arrangement in an analogous endoscope. See Fig. 18 and its description. It would have been obvious to the artisan to add such capability to Eino et al. since Matsunaka et al. teaches that such would facilitate diagnosis of disease.

d. Claim 30 is rejected under 35 U.S.C. 103(a) as being unpatentable over Eino et al. (4,869,237) as applied to claim 1 above, further in view of Sheldon (2,987,960).

Eino et al. fails to teach a rounded end. However, Sheldon shows an analogous side-viewing endoscope having a rounded end. It would have been obvious to the artisan to modify Eino et al. by providing a rounded end since such would make insertion of the endoscope easier than with the blunt end illustrated in Eino et al.

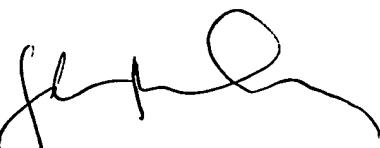
f. Claim 135 is rejected under 35 U.S.C. 103(a) as being unpatentable over Sauer et al. (5,700,236) as applied to claim 134 above, further in view of Yamamoto (6,063,024).

Sauer et al. fails to teach illuminating the image using the same optical path as is used for imaging. However, Yamamoto teaches such an arrangement in an analogous endoscope. It would have been obvious to the artisan to modify Sauer et al. by illuminating the image using the same optical path as is used for imaging since Yamamoto teaches that such an arrangement is beneficial in that it allows the diameter of the insertion portion to be reduced.

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to John M. Mulcahy whose telephone number is (703) 308-3134. The examiner can normally be reached on M-F, 7:30-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Linda C. M. Dvorak can be reached on (703) 308-0994. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9302 for regular communications and (703) 872-9303 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0873.



John M. Mulcahy
August 26, 2002

John M. Mulcahy
Primary Examiner
Art Unit 3739